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TRANSMITTAL OF APPEAL BRIEF (Small Entity)	Docket No. VID-02202/29
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In ~~Re~~ Application Of: **Schwab et al**

Application No. 09/900,827	Filing Date 07/06/2001	Examiner T. Lee	Customer No. 25006	Group Art Unit 2157	Confirmation No. 8990
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Invention: **PORTABLE COMMUNICATIONS DEVICE**

COMMISSIONER FOR PATENTS:

Transmitted herewith in ~~triplicate~~ is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

August 31, 2005

☒ Applicant claims small entity status. See 37 CFR 1.27

The fee for filing this Appeal Brief is: **\$250.00**

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Handwritten signature of John G. Posa

Dated: **Oct. 31, 2005**

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on	
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CC:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of: Schwab et al

Serial No.: 09/900,827

Group No.: 2157

Filed: July 6, 2001

Examiner: T. Lee

For: PORTABLE COMMUNICATIONS DEVICE

APPELLANTS' BRIEF UNDER 37 CFR §1.192

Mail Stop Appeal Brief
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Dear Sir:

I. Real Party in Interest

The real party and interest in this case is Barry H. Schwab and John G. Posa, Applicants and Appellants.

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II. Related Appeals and Interferences

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status of Claims

The present application was filed with 7 claims. Claims 1-2 were canceled by amendment in February 2005. Claims 3 and 5-7 are pending, rejected and under appeal. Claim 4 has been canceled by amendment filed herewith. Claim 3 is the sole independent claim.

**IV. Status of Amendments Filed Subsequent
Final Rejection**

An after-final amendment is being filed herewith. The amendment to claim 3 and the cancellation of claim 4 is reflected in Appendix A - Appealed Claims.

V. Summary of Claimed Subject Matter

Independent claim 1 is directed to a method of improving hands-free operation in a communications device having a speed-dial function. The method includes the steps of storing a plurality of telephone numbers in the device in advance of dialing the numbers, entering an abbreviated command to sequence through the dialing of each stored number, and automatically deleting a number after a call to that number has been completed. (Specification, page 5, lines 8-16).

VI. Grounds of Objection/Rejection To Be Reviewed On Appeal

A. The rejection of claim 1 (as amended) under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,721,577 to Humes in view of Lieben, U.S. Patent No. 6,081,730.

VII. Argument

Claim 4 was rejected under 35 U.S.C. §103(a) over Humes in view of Lieben. By way of an amendment submitted herewith, the limitation of claim 4 has been imported into claim 1.

The Examiner argues that it would have been obvious to combine these references “for the purpose of lowering memory administration complexity and allocation for a mobile [sic].” Appellants disagree.

First, there is no teaching or suggestion *from the prior art* to combine these references. In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Appellants’ claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, there is no teaching or suggestion from Humes or Lieben to add a delete function to Humes. The “purpose of lowering memory administration complexity and allocation” is not a stated

goal of Humes (or Lieben, for that matter). Moreover, to add a delete function to Humes would defeat an important principle of operation of Humes, namely, to have stored links for the same message recipient in case communication using one or more of the links fails. The Examiner has cited Humes as "storing a plurality of numbers in the device in advance of dialing the numbers." However, the disclosure only applies to a single, narrow case --- one in which all of the numbers on the list are associated with a single subscriber (Col. 4, lines 6-16):

In accordance with the teachings of the present invention, the first directory number may be associated with a particular subscriber's office phone. The second directory number may be associated with his or her mobile phone, the third directory number may be associated with his or her home phone, and the last directory number may be associated with his or her pager or voice-mail system. As a result, all of the directory numbers representing a particular user are then sequentially correlated, stored, and maintained in a link list fashion.

Further confirmation is available by examining Figure 2, which depicts "a block diagram of data structure storing a link list of directory numbers within a mobile station in accordance with the present invention". As is clear from the text of the disclosure, Humes contemplates only paths in the "horizontal" direction viz. a sequence that follows the link list 210 to 220 to 230 to ... to 240. To accomplish this, Humes introduces the concept of an "address pointer" (Col. 3, line 54 to Col. 4, line 1) for establishing a link list.

Thus, if Humes were provided with an automatic delete function, the address pointers would not work and the links would be broken, rendering Humes unfit for its stated purpose. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Conclusion

In conclusion, for the arguments of record and the reasons set forth above, all pending claims of the subject application continue to be in condition for allowance and Appellants seek the Board's concurrence at this time.

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Date: Oct. 31, 2005

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APPENDIX A

CLAIMS ON APPEAL

3. In a communications device having a speed-dial function, a method of improving hands-free operation, including the steps of:

storing a plurality of telephone numbers in the device in advance of dialing the numbers; entering an abbreviated command to sequence through the dialing of each stored number; and automatically deleting a number after a call to that number has been completed.

5. The method of claim 3, including the step of skipping a number which was unanswered for later recall.

6. The method of claim 3, wherein the abbreviated command is manually entered.

7. The method of claim 3, wherein the abbreviated command is spoken by a user.

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APPENDIX B

EVIDENCE

None.

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APPENDIX C
RELATED PROCEEDINGS

None.